

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow. Claims 2, 6, 9, and 13 were previously cancelled. Claims 15-28 and 30 were previously withdrawn in response to a restriction requirement. Claims 1, 3-5, 7, 8, 10-12, 14, 29, and 31-32 are pending in this application.

I. Interview Summary

On August 6, 2009, Applicants' representative conducted an interview with the Examiner to discuss the current rejections. The Examiner reviewed the originally filed claims submitted March 12, 2001, and agreed with Applicants' representative that they provide sufficient description to support pending Claims 8, 10-12, and 14. As such, the rejection under 35 U.S.C. § 112, first paragraph should be withdrawn and the claims allowed.

II. Rejection of Claims 8, 10-12, and 14 under 35 U.S.C. § 112

In section 2 of the Office Action, Claims 8, 10-12, and 14 were rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement. More specifically, the Examiner states:

Claims 8, 10-12 and 14 (filed 12/22/08), the newly added limitations recite "A program storage device readable by a machine, tangibly employing a program of instructions executable by the machine to cause the machine to."

Therefore, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(Underlining added). Applicants respectfully disagree.

Below Applicants provide copies of independent Claims 8 and 12 as originally filed on March 12, 2001.

8. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method of recovering location information of a subscriber in a mobile network, the method comprising:

forwarding a registration request from the subscriber to an S-CSCF (Serving-Call State Control Function) including the subscriber's TA (Transport Address);

forwarding a location update from the S-CSCF to an HSS (Home Subscription Server) including the subscriber's TA and the S-CSCF address; and

storing data including the subscriber's TA in the HSS so as to be protected against loss.

12. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method of recovering location information of a subscriber in a mobile network, the method comprising:

forwarding a registration request from the subscriber to an S-CSCF (Serving-Call State Control Function) including the subscriber's TA (Transport Address);

forwarding a location update from the S-CSCF to an HSS (Home Subscription Server) including the subscriber's TA; and

storing data including the subscriber's TA in the S-CSCF so as to be protected against loss.

Applicants respectfully submit that these originally filed claims are part of the specification and provide support for the rejected claims. Thus, Claims 8, 10-12, and 14 comply with the written description requirement. Therefore, Applicants respectfully request withdrawal of the rejection of Claims 8, 10-12, and 14 under 35 U.S.C. § 112.

III. Rejection of Claims 8, 10-12, and 14 under 35 U.S.C. § 101

In section 3 of the Office Action, Claims 8, 10-12, and 14 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. More specifically, the Examiner states:

The preamble of claims 8 and 12 are not clearly supported in the original disclosure because *A program storage device readable by a machine, tangibly employing a program of instructions executable by the machine to cause the machine to* have not been positively disclosed. The claimed limitation “*program storage device*” in claims 10, 11 and 14 is not clearly supported in the original disclosure because “*program storage device*” has not been positively disclosed.

(italics in the original.)

As discussed in Section II. above, the specification, which includes the claims as originally filed, does define “[a] program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to cause the machine to” as recited in Claims 8, 10-12 and 14. Therefore, Applicants respectfully submit that Claims 8, 10-12, and 14 are directed to statutory subject matter. As a result, Applicants respectfully request withdrawal of the rejection of Claims 8, 10-12, and 14 under 35 U.S.C. § 101.

IV. Allowed Claims

In section 5 of the Office Action, Claims 1, 3-5, 7, 29, 31 and 32 are noted as allowed. Applicants thank the Examiner for so noting.

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

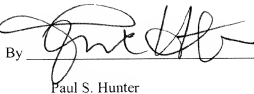
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Wcb being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date August 25, 2009

By 

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4292
Facsimile: (608) 258-4258

Paul S. Hunter
Attorney for Applicant
Registration No. 44,787